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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/034,553	03/03/98	EDWARDS	1-24-B-1117-11

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EXAMINER
JASTRZAB, J

ART UNIT	PAPER NUMBER
1911	

DATE MAILED: 02/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

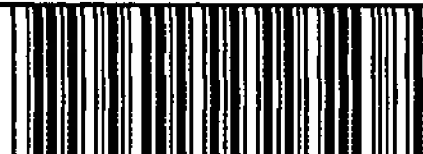
Office Action Summary

Application No.
09/034,553

Applicant(s)
Edwards et al.

Examiner
Jeffrey Jastrzab

Group Art Unit
1911



☒ Responsive to communication(s) filed on 3/3/98 and 7/13/98.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 11-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11-19 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no teaching in the specification to support the use of the currently claimed embodiment as an ablation device. Note in particular page 28 line 31 to page 30 line 24 of the specification wherein the described embodiment is used solely for mapping procedures.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stern '201.

5. Claims 11, 14, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Perlin '239 (cited by Applicants). As to Claim 20, note that the conductive area of the Perlin balloon is 'substantially covered' to form an electrode.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlin. Perlin discloses the invention substantially as claimed less the electrodes being formed on the balloon by ion beam assisted deposition, teaching rather use of a conductive paint or metallic foil. However, absent any teaching of

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criticality or unexpected result by Applicants for the use of such a technique to form the electrodes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized any known technique to place conductive material on the balloon exterior in order to achieve the same functional equivalence.

Specification

8. The disclosure is objected to because of the following informalities: The section heading cited in the supplemental amendment filed 7/13/98 "Related Applications" is incomplete. The appropriate section heading to be cited prior to recitation of related applications is --Cross-Reference to Related Applications--. Correction has been made by the adjudicator.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Desai and Taccardi disclose expandable/collapsible mapping/ablation devices.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Jastrzab whose telephone number is (703) 306-3497. General file and terminal disclaimer inquiries can be directed to the Patent Analyst, Nathanya Ferguson at (703) 306-3476. Fee or status inquiries can be directed to the Patent Assistant, Wan Laymon at (703) 306-3477. The fax number at this location is (703) 308-4363.

JRJ
January 25, 1999



Jeffrey R. Jastrzab
Primary Patent Adjudicator
Patent Reengineering Lab 1911